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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,382	11/17/2003	Gordon Lynn Blumenschein	8285-663	4357

7590

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EXAMINER

HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/716,382

Applicant(s)

BLUMENSCHIN ET AL.

Examiner

Allan Hoosain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/4/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5,14 recite the limitation "the call" in line 2. There is insufficient antecedent basis for this limitation in the claim.

3. Claims 8,19 recite the limitation "the preventing act" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1,3-4,8-10,12-13,17-20 rejected under 35 U.S.C. 102(e) as being anticipated by **Alperovich et al.** (US 6,101,393).

As to Claims 1,10,19-20, with respect to Figures 3-5, **Alperovich** teaches a method comprising preventing a message delivery service from being offered to a caller of an employee (a called

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party) if the employee (called party) is included in a list that identifies employees (called parties) who are restricted from receiving messages from non-employee callers (do not want the message delivery service to deliver caller messages to them) (Figure 5 and Col. 6, lines 7-15).

As to Claims 3,12, **Alperovich** teaches the invention of Claim 1 further comprising:

- receiving a request from the called party to be included in the list (Figure 6); and
- adding the called party to the list (Figure 6 and Col. 5, lines 51-66).

As to Claims 4,13, **Alperovich** teaches the invention of Claim 3, wherein a service management system adds the called party to the list (Col. 5, lines 51-66).

As to Claims 8,17, **Alperovich** teaches the invention of Claim 1, wherein the list comprises numbers (Figure 5, labels 522,532).

As to Claims 9,18, **Alperovich** teaches the invention of Claim 1, wherein a service control point performs the preventing act (Figure 2, label 26 and Figure 4).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 2,5-7,11,14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alperovich** in view of **Helferich** (US 6,259,892) and further in view of **Bartholomew et al.** (US 6,215,858).

As to Claims 2,11, **Alperovich** teaches the invention of Claim 1 further comprising:

**Alperovich** does not teach the following limitation:

“offering the message delivery service to the caller if the called party is not included in the list”

However, it is obvious that **Alperovich** suggests the limitation. This is because **Alperovich** teaches reject callers and returning appropriate messages to callers (Col. 5, lines 47-50).

**Helferich** teaches prompting callers to leave messages for called parties (Figure 4B and Col. 7; lines 8-30). **Bartholomew** teaches offering callers who are not subscribers (on a called party list) voice mail message delivery (Col. 24, lines 57-63 and Col. 25, lines 5-10). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary

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skill in the art to add voice mail service to **Alperovich's** invention to callers as taught by **Helferich's** invention and voice message delivery service to **Alperovich's** invention to called parties who are not subscribers as taught by **Bartholomew's** invention in order to provide voice messages for called parties who are busy.

As to Claims 5,14, **Alperovich** teaches the invention of Claim 1 further comprising determining if the called party is included in the list:

**Alperovich** does not teach the following limitation:

“if the called party has not answered the call after a predetermined time”

However, it is obvious that **Alperovich** suggests the limitation. This is because **Alperovich** teaches later delivery for unavailable subscribers (Col. 4, lines 57-62). **Helferich** teaches prompting callers to leave messages for called parties (Figure 4B and Col. 7, lines 8-30). **Bartholomew** teaches no answer conditions for called parties (predetermined time) (Col. 24, lines 57-63 and Col. 25, lines 5-10). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add voice mail service to **Alperovich's** invention to callers as taught by **Helferich's** invention and no answer conditions to **Alperovich's** invention for monitoring called parties as taught by **Bartholomew's** invention in order to provide voice message services to callers.

As to Claims 6-7,15-16, **Alperovich** teaches the invention of Claim 1,

**Alperovich** does not teach the following limitation:

“wherein the list comprises caller-ID information”

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However, it is obvious that **Alperovich** suggests the limitation. This is because **Alperovich** teaches lists with MSISDN numbers (Figure 5, label 522). **Helferich** teaches prompting callers to leave messages for called parties (Figure 4B and Col. 7, lines 8-30). **Bartholomew** teaches caller ID and names (Col. 17, lines 10-34). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add voice mail service to **Alperovich's** invention to callers as taught by **Helferich's** invention and caller ID information to **Alperovich's** invention to identify callers to subscribers as taught by **Bartholomew's** invention in order to provide voice message services to callers and subscribers.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Sibecas et al.** (US 5,940,756) teach providing page messages to mobile users in an integrated network.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 306-0377 (for customer service assistance)

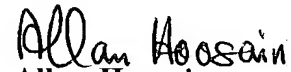
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
**Allan Hoosain**  
**Primary Examiner**  
**11/4/04**